Letter from Mauro, Cameron, Lewis & Massie to Alexander Graham Bell, July 18, 1911

After 10 days, return to MAURO, CAMERON, LEWIS & MASSIE, WASHINGTON, D. C.

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Dr. Alexander Graham Bell, Beinn Bhreagh, Near Baddeck, Victoria County, Nova Scotia, Canada.

S. T. CAMERON. LAW OFFICES TELEPHONE: Washington, Main 3461. REEVE LEWIS, OF New York, 5251 Beekman. C. A. L. MASSIE. **MAURO, CAMERON, LEWIS & MASSIE,** CABLE ADDRESS: Mauro—Washington. Phimauro—New York. F. A. HOLTON. Patents and Patent Causes, CODES USED: Liebers. W. S. KERKAM. CODES USED: Western Union. 700 TENTH ST., N. W., WASHINGTON, D. C. Marconi. RALPH L. SCOTT. (TRIBUNE BLDG., 154 NASSAU ST., NEW YORK.) Note the Address WASHINGTON, July 18th, 1911. 700 TENTH ST., N. W. Dr. Alexander Graham Bell, Beinn Bhreagh, Near Baddeck, Victoria County, Nova Scotia, Canada. Dear Dr. Bell:—

Bell et al., Serial No. 488,779.

We are this morning in receipt of yours of the 14th inst., together with affidavits duly executed by yourself and Mr. Baldwin. These affidavits we shall today file in the Patent Office. We note that you have forwarded the other affidavits to Messrs. Curtiss and McCurdy for their signatures, and we shall expect to receive the same from them shortly.

Your telegram of the 13th inst., in the following words:

“Have just returned to Baddeck and Baldwin has arrived from Europe. Telegraph whether you have secured extension. If so, we will do our best with affidavits.” — was received

after we had prepared and filed in the Patent Office a communication in reply to official letter of July 13th, 1910. We enclose a copy of this amendment and argument herewith. No good results would have followed from an attempt to have secured an extension of the time for filing our response to the official letter in this matter, and accordingly we did the best we could in the absence of the affidavits in question.

Baldwin, Serial No. 485,281.

We have also prepared a reply to the last official letter in this matter, and have filed the same in the Patent Office, together with the affidavits recently executed by yourself, Mr. Baldwin, Mr. Curtiss and Mr. McCurdy. We enclose herewith copy of said communication for your information.

Yours sincerely, K-F. Encs. Mauro Cameron Lewis & Massie. Per

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COPY IN THE UNITED STATES PATENT OFFICE. Div. 22, Room 249, Frederick W. Baldwin, Responsive to official Filed March 23, 1909, action of April 15, 1911. Serial No. 485,281, Flying Machines. Washington, D. C., July 18, 1911. Hon. Commissioner of Patents, Sir:—

In view of official letter of April 15th, 1911, we file herewith affidavit of Frederick W. Baldwin, the applicant, and affidavits of Dr. Alexander Graham Bell, Glenn H. Curtiss and J. A. D. McCurdy, the gentlemen who, with Mr. Baldwin (and the late Lieut. Thomas E. Selfridge) constituted the Aerial Experiment Association. In view of these affidavits, it is understood that the rejection of claims 1, 5, 7 and 17 will be withdrawn.

The rejection of claims 10, 11, 12, 13 and 14 on Lamson, 666,427 of record “in view of” Hammond 184,520, is thought to be improper. This Hammond patent is clearly in an art which is not analogous to that of aeronautics. The invention of the patent is an improvement in the “construction of truss-girders for bridges and other structures”. It

is contended that a truss-girder for bridges and such structures is so remote from an aeroplane construction as to render a reference disclosing the same useless as an anticipation of a flying machine construction. In connection with this contention, we call the Examiner's attention to the decision of the Circuit Court of Appeals for the 8th Circuit in the case of the National Hollow Brake-Beam Co. et al. v. Interchangeable Brake-Beam Co. 106 F.R., page 693. In that case the patent which was being litigated was an improvement in brake beams for railway cars, and it was sought to show that the patent was invalid by anticipation in view of a similar structure in an art which the Court held to be non-analogous to that of railway cars. In this decision, which the Examiner will recognize as a famous authority, the Court say:

“Regardless, however, of the similarity or difference of these devices the art of constructing whiffle-trees, like the art of building bridges, is so remote from that of manufacturing brake beams for railway cars that trusses for either of the former purposes can not be permitted to anticipate or limit the scope of the patents of the appellants. The circumstances under which trusses for bridges and for whiffletrees are to be used, the essential requirements of structures for those purposes, the functions they are to perform, — all these are so radically different from the circumstances, requirements and functions which condition the use of railway brake beams that the efficiency and practicability of specific trusses for the former structures would not be likely to suggest to the skilled mechanic their use or their efficiency for railway brake beams. Trusses for the former purposes were neither designed, apparently adapted, nor actually used to perform the function of stopping railway trains, and the art which they illustrate was not in any way analogous to that in which the patentee, Hien, invented and used his combinations.”

In view of this decision, it is unnecessary for applicant to argue that the art of aeronautics is non-analogous to the art involving bridges. These two arts are certainly more widely separated in connection with the essential requirements of structures, the functions they are to perform and the conditions which are encountered than exist in connection with the railway art and the art involving whiffle-trees. This is very apparent for both brake

beams and whiffletrees are used in connection with vehicles. In view of the foregoing, a discussion of these references would be useless.

Favorable action is requested.

Respectfully, Attorneys. K/W

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COPY IN THE UNITED STATES PATENT OFFICE. Div. 22, Room 249, Alexander Graham Bell et al., Responsive to Official Serial N o 488,779, Action of July 13, 1910. Filed April 8th, 1909, Flying Machines. Washington, D. C., July 13th, 1911. Hon. Commissioner of Patents, Sir:—

Please amend as follows:—

Erase claim 1, and substitute:—

—1. In a flying machine, the combination of a plurality of supporting surfaces, means uniting said supporting surfaces, and a pair of normally horizontal rudders one on each side of the medial fore and aft line of the structure and each mounted outside of the lateral marginal extremities of said supporting surfaces.—

Claims 6 and 8, line 5, erase the comma (,), and substitute —and outside of the marginal extremities of said supporting surfaces—.

Claim 7, line 4, erase the comma (,), and substitute —and outside of the marginal extremities of said supporting surfaces—.

Claim 10, line 2, erase “concavo-convex”.

Line 4, erase “with their concave sides toward each other,”.

Line 6, after “structure” insert — and outside of the marginal extremities of said supporting surfaces—.

Add as claims 15 and 16:—

—15. In a flying machine, the combination of a pair of superposed supporting surfaces, means uniting said supporting surfaces into a rigid non-flexing structure, a 2 lateral balancing rudder on each side of the medial fore and aft line of the structure and mounted to turn on an axis substantially parallel to the longitudinal axis of the machine, and means connecting said rudders whereby a movement of one imparts a reverse movement to the other, and operating means connected to both of said rudders.

15. In a flying machine, the combination of a plurality of suitably spaced surfaces, a member projecting outside of the lateral marginal extremities of each of said surfaces and in line with the front marginal edge thereof, a rudder fulcrumed to each of said projecting members, and means for operating said rudders.—

REMARKS.

This amendment is made in view of official action of June 13th, 1910.

British patent to Chappell, N o 21,923, accepted Sept. 3d, 1908 (sealed at least three months later); French patent to Hilsmann, N o 389,098, published Aug. 31st, 1908 ; French patent to Bonnet-Labranche, N o 393,413, published Dec. 22d, 1908 ; French patent to Foucault, N o 394,596, published Jan. 27th, 1909 ; French patent to Schmid & Bauer, N o 394,779, published Feb. 1st, 1909 ; French patent to Duray & Matthys, N o 395,282, published Feb. 18th, 1909 ; French patent to Voisin, N o 386,396, published June 11th, 1908 ; and U.S. patent to Weidel, N o 951, 585, dated Nov. 8th, 1910 (application filed Sept. 17th, 1908), are too late in date to be available as references in this case. Applicants conceived the invention of this application on or prior to March 17th, 1908, at Hammondsport, New York, and proceeded diligently to embody the same in a full-

sized operative device which was successfully operated at Hammondsport, New York. The machine in question was one of the famous machines of the Aerial Experiment Association (which was an association 3 composed of the applicants), which was operated principally at Hammondsport, in the years 1908 and 1909, and which was so widely described and commented on in the public prints in that year. In view of the fact that applicants proceeded diligently, after their conception, to reduce the invention to practice, they are entitled to the date of their conception in overcoming references, under the well-known doctrine established by Ex parte Gasser, 17 O.G., 597; Ex parte Saunders, 23 O. G., 1224; Ex parte Donovan, 52 O.G., 309; Ex parte Hunter, 49 O.G., 733; and Ex parte McElroy, 140 O.G., 1207. It will, therefore, be unnecessary to further consider the references enumerated.

So far as the Laroze French patent is concerned, it is not available as a reference for the reason that it does not respond to the requirement for such a full, clear and exact disclosure as is necessary to defeat a meritorious invention. The contents of this Laroze patent are so vague and uncertain that one inquiring into the disclosures thereof is irresistably carried on an excursion into the fields of conjecture and surmise. This reference is the product of a patent system which does not provide for examinations on the merits of applications, and under which patents are granted if the application is in proper form . Such a vague and indefinite disclosure as is contained in the patent is insufficient as an anticipation. Laroze unquestionably had quite a few ideas and theories, but “neither an idea nor a thought is patentable”. As was stated by the Court in American Graphophone Co. v. Leeds and Catlin, et al., 170 F., 327:—

“It may be conceded that when Adams-Randall wrote the language quoted, he was possessed of an idea of some kind, but neither an idea nor a thought is patentable, and neither can anticipate a patent. Assuming the existence of the idea, what was it, how was it to be carried out , and what was the result produced?”

How was the Laroze idea (whatever it was!) to be carried out, and what were the means? The patentee expressly disclaims that he discloses means for performing the functions of the device. (See page 1, lines 37–44 of the specification, where he states:—

“L'appareil dont la théorie est faite ci-apres n'est que l'un des modeles multiples qui peuvent en en deriver. Aussi la sollicitation d'un brevet ne vise-t-elle pas cet appareil, mais l'ensemble des procédés dont il est l'application rationelle mais provisoire.”

It cannot, therefore, be successfully contended that any person skilled in the art could build a complete and operative machine from the disclosures of this patent “ without the necessity of making experiments ” (Valvona v. D'Adamo, 135 F., 544). The case cited was one in which a prior foreign patent was invoked as a reference, but it was held that it did not anticipate, for the reason stated in the preceding sentence.

It is fundamental in the law that in order to anticipate, it is necessary that —

“a prior publication contain a substantial representation of the patented improvement in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains to make, construct and practice the invention patented. It must be an account of a complete and operative invention, capable of being put into practical operation”. (Pettibone, Mulliken & Co. v. Pa. Steel Co., 133 F., 730).

It is obvious that this Laroze patent does not respond to these requirements, and equally true that much experimentation, to say the least, would be required of one skilled in the art to construct a complete and operative structure from the disclosures of this patent.

There is much theory set forth in this Laroze patent, but that is not enough to make it available as a reference, for, as so forcibly stated in Kings County Raisin & Fruit Co. et al. v. U.S. Consolidated Seeded Raisin Co., 182 F., 59:

“It is one thing to invent the theory of a machine. It is quite another thing to invent a successfully operating machine.”

It is unnecessary to further discuss this Laroze patent for the reasons given.

Claim 1 as redrawn is free from the rejection on the ground of aggregation, and clearly distinguishes from the patents to Godek and Ferber of record, the only two references cited against this claim not heretofore disposed of. The patent to Godek discloses two planes f and g mounted between the supporting surfaces, and inside of the lateral marginal extremities thereof instead of “outside of the lateral marginal extremities of said supporting surfaces”, as required by the claim. The patent to Ferber is not pertinent for the reason that it fails to respond to the requirement just quoted. The specification says that the “rudders of direction have the form of a right angle triangle turning around an axis 19, which forms their hypothenuse.” And an inspection of the drawings discloses that, if lines were drawn through the extremities of 18, parallel with the line of flight, said “rudders of direction” would be within instead of “without” the lateral marginal extremities of said supporting surfaces.

The patents to Laroze, Hilsmann, Bonnet-Labranche, and Foucault, cited against claim 2, having been disposed of as above indicated, discussion of the rejection of this claim is rendered unnecessary.

Claims 3, 4, 5 and 9 were rejected on Laroze, Hilsmann, Bonnet-Labranche and Foucault, in view of Ferber. Each of these claims requires that the horizontal rudder shall be mounted “outside of the lateral marginal line” of the supporting surface. The four references first indicated having been disposed of, only the Ferber patent remains. 6 As the claims were rejected on the patents mentioned “in view of Ferber”, further comment appears unnecessary, as the Examiner evidently only cited Ferber to show the “superposed planes” — it being obvious that Ferber does not disclose horizontal rudders mounted “outside of each lateral marginal line” of the supporting surfaces.

Claims 6 and 7 were rejected on Laroze, Ferber, Bonnet-Labranche, Foucault and Chappell. All of the references have been disposed of save Ferber. These claims, as now amended, require that the lateral balancing rudders shall be mounted “outside of the marginal extremities of said supporting surfaces”, and in this requirement clearly differentiate from Ferber.

All of the references cited against claims 8 and 14 have been disposed of except Ferber and Wright. These claims were rejected on certain patents (including Ferber) “ in view of Wright”. Claim 8, as amended, requires that the lateral balancing rudders shall be mounted “outside of the marginal extremities of said supporting surfaces”, and thus clearly differentiates over Ferber. It is unnecessary to discuss the Wright patent, which was cited only to show a member engaging the body of the operator.

The rejection of claim 14 on Ferber was evidently made inadvertently. The claim requires that the balancing rudders shall be mounted “outside of the lateral marginal lines” of the device, and clearly Ferber does not disclose this feature. The Wright patent was cited only to show a member engaging the body of the operator, and in view of the foregoing remarks, no discussion of this patent is necessary.

Claim 10 has been amended to avoid the rejection on the ground of aggregation. It has further been amended to require that the balancing rudders shall be “outside of the 7 marginal extremities of said supporting surfaces”, and as so amended clearly defines over Ferber, the only remaining reference — Eichenfels having been cited to the concavo-convex feature of the planes.

The patents to Bonnet-Labranche and Voisin having been disposed of, it is unnecessary to discuss the rejection of claim 12.

Further, the elimination of the patents just referred to obviates the necessity for discussion of the rejection of claim 13. This claim was rejected on Bonnet-Labranche and Voisin, “

in view of" certain other patents. The fact that these other patents might show "steering wheels and rudders connected for simultaneous movement" is immaterial, in view of the elimination of the Bonnet-Labranche and Voisin patents.

New claim 15 defines over Ferber in requiring "a balancing rudder * * * mounted to turn on an axis substantially parallel to the longitudinal axis of the machine ", and over Godek in requiring "means connecting said rudders whereby a movement of one imparts a reverse movement to the other". In the Godek structure, the elements f and g are independently operated.

Now claim 16 clearly defines over the art in requiring "a member projecting outside of the lateral marginal extremities of each of said surfaces and in line with the front marginal edge thereof".

Favorable action is requested.

Respectfully, Attorneys. K-F.